IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	Atty. Docket No.: 000479.00023
Steven Rizzi et al.	
Serial No.: 09/876,173	Group Art Unit: 3622
Filed: June 8, 2001	Examiner: Janvier, Jean D.
For: System and Method of Providing Advertising on the Internet	Confirmation No.: 5726

APPEAL BRIEF

U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief-Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Notification of Non-Compliant Appeal Brief mailed November 23, 2007, this is a Replacement Appeal Brief in accordance with 37 C.F.R. § 41.37 in support of Appellants' May 22, 2007. Appeal is taken from the Advisory Action mailed March 21, 2007 (hereinafter referred to as *Advisory Action*), and the Final Office Action mailed December 15, 2006 (hereinafter referred to as, *Final Action*). Please charge any necessary fees in connection with this Appeal Brief to our Deposit Account No. 19-0733.

REAL PARTY IN INTEREST
37 C.F.R. § 41.37(c)(1)(i)

The owner of this application, and the real party in interest, is Science Applications International Corporation.

RELATED APPEALS AND INTERFERENCES
37 C.F.R. § 41.37(c)(1)(ii)

There are no related appeals and interferences.

STATUS OF CLAIMS
37 C.F.R. § 41.37(c)(1)(iii)

Claims 1-6, 8-9, and 11-40 stand rejected and are shown in the attached Claims Appendix. Claims 7 and 10 are canceled. Claims 1, 21, 30, and 37 are independent claims. Only pending claims 1-6, 8-9, and 11-40 are shown in the attached Claims Appendix.

Appellants hereby appeal the rejection of claims 1-6, 8-9, and 11-40.

STATUS OF AMENDMENTS
37 C.F.R. § 41.37(c)(1)(iv)

Appellants' Request for Reconsideration filed February 28, 2007, did not include amendments to the claims. As such, the Claims Appendix represents the claims based on entry of the Response and Amendment filed September 20, 2006.

SUMMARY OF CLAIMED SUBJECT MATTER
37 C.F.R. § 41.37(c)(1)(v)

In making reference herein to various portions of the specification and drawings in order to explain the claimed invention, Appellants do not intend to limit the claims; all references to the specification and drawings are illustrative unless otherwise explicitly stated.

The present invention provides for systems and methods of providing advertising on the Internet. More specifically, the present invention is directed to systems and methods for providing advertising that is tailored to a user without creating a profile of the user. *Specification*, p. 1, para. [01] and p. 3, para. [11].

Providing support for independent claim 1 and in accordance with one or more aspects of the present invention, the invention includes a system for providing Internet advertising. The system includes an advertising server 140 comprising a web server 120 having at least one applet 122. *Specification*, p. 5, para. [24] and Figure 1 (as amended in the Response and Amendment filed September 20, 2006). The advertising server 140 further includes a database 144 and a servlet 150 for sending said at least one applet 122 to a web browser 104 on another computer 100 and receiving textual content read from said web browser 104 by said at least one applet 122, said advertising server 140 comparing said textual content to keyword data stored in said database 144 to determine whether to display an ad at a location 108 on said web browser 104.

- 2 -

Specification, p. 5, paras. [24]-[25] and Figure 1 (as amended in the Response and Amendment filed September 20, 2006). No user profiling data is forwarded from the computer 100 to the advertising server 140. The applets 122 do not cause the textual content to be cached, either in a user's computer 100, a web server 120 or an advertising server 140. Consequently, users are provided a higher degree of privacy. No data is collected that might be used to profile the users. *Specification*, p. 8, para. [34]. No user profiling data is forwarded to the advertising server 140 for collection, and any temporary information that might apply to privacy concerns never leaves the user's computer 100, and such temporary information is destroyed when the browser is closed. *Specification*, pp. 9-10, para. [43].

Providing support for independent claim 30 and in accordance with one or more aspects of the present invention, the invention includes a method of providing real-time advertising over the Internet. A database 144 maintains a plurality of ads and keyword data for each of the ads (steps 200 and 202). *Specification*, p. 8, para. [35] and Figure 2. An applet 122 is sent to a browser on a user's computer 100 (step 206). *Specification*, p. 8, para. [36] and Figure 2. Textual content displayed on the browser is read using the applet (step 210). *Specification*, p. 8, para. [36] and Figure 2). The textual content read by the applet 122 is compared with the keyword data for each of the ads and an ad having keyword data matching the textual content is displayed when the comparing step produces a match (steps 212 and 216). *Specification*, p. 8, para. [37], p. 9, para. [39], and Figure 2. No user profiling data is forwarded from the user's computer 100 to an advertising server 140. The applets 122 do not cause the textual content to be cached, either in a user's computer 100, a web server 120 or an advertising server 140. Consequently, users are provided a higher degree of privacy. No data is collected that might be used to profile the users. *Specification*, p. 8, para. [34]. No user profiling data is forwarded to the advertising server 140 for collection, and any temporary information that might apply to privacy concerns never leaves the user's computer 100, and such temporary information is destroyed when the browser is closed. *Specification*, pp. 9-10, para. [43].

Providing support for independent claim 21 and in accordance with one or more aspects of the present invention, the invention includes a method of providing Internet advertising. Ads are uploaded to an advertising server 140 (step 200). *Specification*, p. 8, para. [35] and Figure 2. Keyword data for each ad is selected (step 202). *Specification*, p. 8, para. [35] and Figure 2. At

least one applet 122 is sent to a web browser in a user interface 104 on a user's computer 100 (step 206). *Specification*, p. 8, para. [36] and Figure 2. Textual content displayed on the web browser is received from said at least one applet 122 (step 210). *Specification*, p. 8, para. [36] and Figure 2. The textual content read by the at least one applet 122 is compared with the keyword data (step 212) and an ad having keyword data matching the textual content is displayed when the comparing step produces a match (steps 212 and 216). *Specification*, p. 8, para. [37], p. 9, para. [39], and Figure 2. No user profiling data is forwarded from the user's computer 100 to an advertising server 140. The applets 122 do not cause the textual content to be cached, either in a user's computer 100, a web server 120 or an advertising server 140. Consequently, users are provided a higher degree of privacy. No data is collected that might be used to profile the users. *Specification*, p. 8, para. [34]. No user profiling data is forwarded to the advertising server 140 for collection, and any temporary information that might apply to privacy concerns never leaves the user's computer 100, and such temporary information is destroyed when the browser is closed. *Specification*, pp. 9-10, para. [43].

Providing support for independent claim 37 and in accordance with one or more aspects of the present invention, the invention includes a system for providing Internet advertising. The system comprises a computer 100 including a web browser and a display unit 102, the web browser receiving at least one applet 122 from an advertising server 140. *Specification*, p. 5, paras. [21]-[25] and Figure 1 (as amended in the Response and Amendment filed September 20, 2006). The at least one applet 122 reads textual content displayed on the web browser. *Specification*, p. 6, para. [26] and Figure 1 (as amended in the Response and Amendment filed September 20, 2006). The web browser displays an ad specifying keyword data when words in the textual content match the keyword data. *Specification*, p. 6, para. [26] and Figure 1 (as amended in the Response and Amendment filed September 20, 2006). The ad is received from the advertising server 140. *Specification*, p. 5, para. [24], p. 6, para. [26] and Figure 1 (as amended in the Response and Amendment filed September 20, 2006). No data is collected to profile a user of the computer 100. The applets 122 do not cause the textual content to be cached, either in a user's computer 100, a web server 120 or an advertising server 140. Consequently, users are provided a higher degree of privacy. No data is collected that might be used to profile the users. *Specification*, p. 8, para. [34]. No user profiling data is forwarded to

- 4 -

the advertising server 140 for collection, and any temporary information that might apply to privacy concerns never leaves the user's computer 100, and such temporary information is destroyed when the browser is closed. *Specification*, pp. 9-10, para. [43].

Providing support for dependent claims 5 and 6, and in accordance with one or more aspects of the present invention, applets 122 may be loaded onto a Java™ enabled web browser that may execute applets written in the Java™ programming language. *Specification*, p. 7, para. [33].

Providing support for dependent claim 23, and in accordance with one or more aspects of the present invention, a comparison of textual content and keywords or phrases is made in step 212 of Figure 2. *Specification*, p. 8, para. [37], ll. 1-2, and Figure 2. If the keywords or phrases do not match in step 212, no banner ad will be displayed in step 214. *Specification*, p. 8, para. [38], ll. 1-2, and Figure 2.

Providing support for dependent claims 34-36, and in accordance with one or more aspects of the present invention, the applets 122 do not cause the textual content to be cached, either in a user's computer 100, a web server 120 or an advertising server 140. Consequently, users are provided a higher degree of privacy. No data is collected that might be used to profile the users. *Specification*, p. 8, para. [34].

Providing support for dependent claim 38, and in accordance with one or more aspects of the present invention, the applets 122 do not cause the textual content to be cached, either in a user's computer 100, a web server 120 or an advertising server 140. Consequently, users are provided a higher degree of privacy. No data is collected that might be used to profile the users. *Specification*, p. 8, para. [34]. No user data is forwarded to the advertising server 140 for collection, and any temporary information that might apply to privacy concerns never leaves the user's computer 100, and such temporary information is destroyed when the browser is closed. *Specification*, pp. 9-10, para. [43].

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
37 C.F.R. § 41.37(c)(1)(vi)

The remaining grounds of rejection on appeal include:

1)   Claims 1-6, 8-9, and 11-40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by International Publication No. WO 97/41673 to Gerace (hereinafter referred to as "*Gerace*").

2)   Claims 1-6, 8-9, and 11-40 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,804,659 to Graham (hereinafter referred to as "*Graham*").

ARGUMENT
37 C.F.R. § 41.37(c)(1)(vii)

1.   Claims 1-6, 8-9, and 11-40 are not anticipated by *Gerace*.

The *Final Action* and the *Advisory Action* reject claims 1-6, 8-9, and 11-40 as being anticipated by *Gerace*. Appellants respectfully traverse this rejection.

Initially, Appellants object to the narrow and improper reading of the claim language in the *Final Action*. Specifically, the *Final Action* begins the argument for this rejection stating, "[i]n claims 1, 21, 30, and 37, the claim amendment and new claim limitation is read as 'no user profiling data are forwarded to the advertising server 140 for collection,' wherein the advertising server 140 is an external advertising server or a third party advertising server that should not collect or access the user's profile data." (*Final Action*, p. 2). The *Final Action* improperly narrows the claim language of independent claims 1, 21, 30, and 37, and thus all of the pending claims 1-6, 8-9, and 11-40, by requiring an advertising server that must be external or a third party server that should not collect or access a user's profile data. Such a limitation in rejecting the claims is completely improper. For example, with respect to Appellants' claim 1, an advertising server comprising various elements is recited. There is nothing in the claim language of claim 1, nor any other claim, to require that the advertising server be an "external advertising server or a third party advertising server" as required by the claims. With respect to claim 1, the claim language speaks for itself and unnecessary and improper limitations are simply not allowed.

In order establish a prima facie case of anticipation under 35 U.S.C. § 102(b), each and every feature of the claim must be taught by the reference. *Gerace* describes a method and system for targeting of appropriate audiences based on psychographic or behavioral profiles of end users. (*Abstract*). *Gerace* uses agate information to determine the profile of a computer

- 6 -

user, and in particular the behavioral or psychographic profile of a user. (p. 3, ll. 2-5). The *Gerace* system includes a tracking and profiling member for recording user activity including presentation (format) preferences of users such as a User Object to track user actions in a history profiling table. (p. 3, ll. 8-19 and p. 4, ll. 23-25, and reference element program 31). The *Gerace* system is "a software program 31 operated on and connected through a server 27 to the Internet for communication among the various networks 19 and/or processors 11, 13, 15, 17 and other end users connected through respective servers 25." (p. 6, ll. 22-26 and Figure 1). "[P]rogram 31 in its most general form has an agate data assembly 71, a user profiling member 73, an advertisement module 75 and a program controller 79." (p. 8, ll. 1-4 and Figures 1 and 2; see also, p. 8, ll. 15-31).

For each and every user, the program 31 of the *Gerace* system creates a user profile from the agate information viewing habits of the user. (p. 7, ll. 19-21). Advertisements are then displayed to users *in accordance with the psychographic profile of the user*. (p. 3, ll. 28-31). The system generates a custom Home Page, including a user's preferred agate information based upon the user profile. Under the *Gerace* system, user activity is monitored in order to create a user profile and advertisements are then shown based upon this user profile. In fact, *Gerace* requests cookies on a user's PC to be transmitted upstream. (p. 25, l. 31 to p. 26, l. 6).

Appellants' independent claims 1, 21, 30, and 37:

Gerace fails to teach or suggest every feature of Appellants' claim 1. Appellants' claim 1 recites, among other features "wherein no user profiling data is forwarded to the advertising server." As recited in Appellants' claim 1, at least one applet reads textual content displayed on the web browser and the advertising server compares the read textual content to keyword data to determine whether display an ad on the web browser. No data is forwarded to the advertising server. As described in Appellants' original written description, user privacy is a concern and tracking and generation of a user profile would not be desired, as opposed to the *Gerace* system. (See Appellants' original written description, paragraphs [10]–[11], [13], and [15]). The *Gerace* system *requires* generation of a user profile in order to generate a custom Home Page for a user. Under the *Gerace* system, advertisements are only displayed based upon the generated user profile.

- 7 -

Still further, the *Final Action* admits this requirement of the *Gerace* system. "The user's psychographic profile and demographic profile are collected from the user during a registration or an enrollment or sign-up process. Thereafter, the psychographic profile is constantly refined using the user's viewing habits (or exposure to content) and computer activity." (*Final Action*, p. 3). Appellants' claim 1 is patently distinct from *Gerace* for at least the reason that *Gerace* forwards user profiling data.

In addition, and in response to Appellants' response to the non-final Office Action of June 30, 2006, the *Final Action* unduly limits the claim language. Specifically, the *Final Action* states,

> Here, it appears rather, in the present invention, that the advertising server 140 represents an external third party's server that should not have access to the user's profile. To this end, as long as the user's profile data are not collected and provided to an external advertising server 140 or external party, the claim limitation or claim amendment is met. Indeed, in the prior art of record (the Gerace's or Graham's), the advertising server is part of the internal system and hence, the user's profile data are not collected and provided to any third party or external advertising server, but rather collected and used internally for targeting the users contrary to the Appellants' contention. (*Final Action*, p. 10).

Appellants strenuously disagree with the completely improper limitations that the *Final Action* places on the claim language of claim 1. Specifically, Appellants' claim 1 feature, "wherein no user profiling data is forwarded to the advertising server," recites absolutely ___nothing___ as to the advertising server being of a third party or external. The *Final Action*'s attempt to limit the claim language to being external from a designated internal system or providing to a third party is wrong and improper as such a limitation is simply not within the claim. As specifically admitted by the *Final Action* in the above portion, "the user's profile data … [are] collected and used internally for targeting the users." Contrary to the comments and limitations of the *Final Action*, *Gerace* does forward user profiling data to an advertising server 27, the same advertising server 27 that allegedly sends the at least one applet. "Each sponsor has one ore more ad packages maintained by respective Ad Package Objects 33b of the sponsor. In each Ad Package Object 33b (Fig. 5b) there is indicated the sponsor ID, start and end dates and times, and pricing of the ad packages….Ad Package Object 33b records the number of hits and click throughs as

- 8 -

tracked/monitored during user operation of the program." (*Gerace*, p. 22, l. 36 to p. 23, l. 14, emphasis added).

Therefore, because *Gerace* fails to teach or suggest each and every feature of Appellants' claim 1, withdrawal of the present rejection is respectfully requested.

Appellants' claims 21, 30, and 37 include similar language as recited above with respect to Appellants' claim 1. For at least similar reasons as recited above with respect to Appellants' claim 1, *Gerace* fails to teach or suggest every feature of Appellants' claims 21, 30, and 37. As such, Appellants' claims 21, 30, and 37 are allowable over the art of record.

Claims 2-6, 8-9, 11-20, and 31-34, which depend from claim 1, are allowable over the art of record for all the reasons given above concerning their respective base claim, and further in view of the novel features recited therein. Appellants' claims 22-29 and 35, 36, and 38-40, which depend from claims 21, 30, and 37, respectively, are allowable over the art of record for at least the same reasons as their ultimate base claim.

Appellants' dependent claims 5 and 6:

Appellants' claim 5 recites, "said web browser is a Java™ enabled web browser" and claim 6 recites, "said at least one applet is a Java™ applet." No portion of *Gerace* teaches or suggests at least these features of Appellants' claims 5-6 or anything with respect to Java™.

Appellants' dependent claim 23:

Appellants' claim 23 recites, among other features, "displaying no ad when said textual content does not match said keyword data." The *Final Action* fails to recite a specific portion of *Gerace* as teaching or suggesting at least this feature of dependent claim 23. Under the *Gerace* system, when a user logs on to the system, advertisements are displayed to him/her. *Gerace* fails to teach or suggest that advertisements are not displayed when there is no textual match to keyword data.

Appellants' dependent claims 34, 35, and 36:

Still further, Appellants' dependent claim 34 recites, among other features, "wherein no data is collected to profile a user of the web browser." As explicitly admitted in the *Final Action*,

"the psychographic profile is constantly refined using the user's viewing habits (or exposure to content) and computer activity." (*Final Action*, p. 3). By the very operation of *Gerace*, user data **_must be collected_** and used for the psychographic profiling. Therefore, *Gerace*, by its very operation, cannot perform the features of Appellants' claim 34. As such, for at least this additional reason, *Gerace* fails to teach or suggest the features of Appellants' claim 34.

Appellants' dependent claims 35 and 36 include similar features as recited above with respect to Appellants' claim 34. As described above with respect to Appellants' claim 34, *Gerace*, by its very operation, cannot perform the features of Appellants' claims 35 and 36. As such, for at least this additional reason, *Gerace* fails to teach or suggest the features of Appellants' claims 35 and 36.

Appellants' dependent claim 38:

Appellants' dependent claim 38 recites, among other features, "wherein no user profiling data is forwarded from the computer to the advertising server." No data is forwarded to the advertising server. As described in Appellants' original written description, user privacy is a concern and tracking and generation of a user profile would not be desired, as opposed to the *Gerace* system. (See Appellants' original written description, paragraphs **[10]**–**[11]**, **[13]**, and **[15]**). The *Gerace* system **_requires_** generation of a user profile in order to generate a custom Home Page for a user. Under the *Gerace* system, advertisements are only displayed based upon the generated user profile.

Still further, the *Final Action* admits this requirement of the *Gerace* system. "The user's psychographic profile and demographic profile are collected from the user during a registration or an enrollment or sign-up process. Thereafter, the psychographic profile is constantly refined using the user's viewing habits (or exposure to content) and computer activity." (*Final Action*, p. 3). Appellants' claim 38 is not anticipated by *Gerace* for at least the reason that *Gerace* forwards user profiling data.

2. Claims 1-6, 8-9, and 11-40 are not anticipated by *Graham*.

The *Final Action* and the *Advisory Action* reject claims 1-6, 8-9, and 11-40 as being anticipated by *Graham*. Appellants respectfully traverse this rejection.

Initially, Appellants object to the narrow and improper reading of the claim language in the *Final Action*. Specifically and as similarly described above, the *Final Action* begins the argument for this rejection stating, "[i]n claims 1, 21, 30, and 37, the claim amendment and new claim limitation is read as 'no user profiling data are forwarded to the advertising server 140 for collection,' wherein the advertising server 140 is an external advertising server or a third party advertising server that should not collect or access the user's profile data." (*Final Action*, pp. 7-8). The *Final Action* improperly narrows the claim language of independent claims 1, 21, 30, and 37, and thus all of the pending claims 1-6, 8-9, and 11-40, by requiring an advertising server that must be external or a third party server that should not collect or access a user's profile data. Such a limitation in rejecting the claims is completely improper. For example, with respect to Appellants' claim 1, an advertising server of various elements is recited. There is nothing in the claim language of claim 1, nor any other claim, to require that the advertising server be an "external advertising server or a third party advertising server" as required by the claims. With respect to claim 1, the claim language speaks for itself and unnecessary and improper limitations are simply not allowed.

In order establish a prima facie case of anticipation under 35 U.S.C. § 102(e), each and every feature of the claim must be taught by the reference. *Graham* describes an internet target marketing method and system for distributing online advertising to viewers based upon the viewers' interests. (*Abstract*). As with the *Gerace* system described above, the *Graham* system uses a personal profile of a user. (Col. 6, ll. 7-11). The *Graham* system includes a concept comparator 106 that compares *user concept output 20 from profile content recognizer 102* and advertiser concept output 22 from advertisement concept recognizer 104 *to produce as an output a "best ad," 30, an advertisement targeted to the user of client browser 12a based on the content of the document, the user's interests and the content of the advertisements*. (Col. 5, ll. 58-64, emphasis added). Advertisements are then displayed to users based on user's concepts of interest. (Col. 6, l. 17). Even the content of the document is based upon the user selectable concepts of interest. (Col. 7, ll. 50-53). As part of the process of analyzing a document to

identify discussion corresponding to one or more user selectable concepts of interest, reference in *Graham* is made to FIGs. 5-8. (Col. 8, ll. 46-51).

In description of FIG. 5, the *Graham* system utilizes an annotation agent 508 that depends on inputs by a user. The concepts of interest and other user-specific information are maintained in a user profile file 516. (Col. 11, ll. 23-31). Then, particular patterns in parsed text are determined by the contents of user profile 516 (col. 11, ll. 57-60), and a Bayesian belief network 700 uses user profile file 516 for source in order to ultimately output an advertisement (col. 12, ll. 52-55). Under the *Graham* system, a user profile file is created and advertisements are then shown based upon this user profile file.

Appellants' independent claims 1, 21, 30, and 37:

Graham fails to teach or suggest every feature of Appellants' claim 1. Appellants' claim 1 recites, among other features, "wherein no user profiling data is forwarded to the advertising server." As recited in Appellants' claim 1, at least one applet reads textual content displayed on the web browser and the advertising server compares the read textual content to keyword data to determine whether display an ad on the web browser. No data is forwarded to the advertising server. The *Graham* system requires generation of a user profile file in order to generate an advertisement for a user. Under the *Graham* system, advertisements are only displayed based upon the generated user profile file.

Appellants' claim 1 is patently distinct from *Graham* for at least the reason that *Graham* displays ads based upon a user profile file forwarded to an ads database. Appellants disagree with the limitations that the *Final Action* places on the claim language of claim 1. At page 9, the *Final Action* states, "[h]ere, the advertising server is part of the internal system and hence, the user's profile data are not collected and provided to any third party or external advertising server, rather are collected and used internally for targeting the users." Specifically, Appellants' claim 1 feature, "wherein no user profiling data is forwarded to the advertising server," recites absolutely **_nothing_** as to the advertising server being of a third party or external. The *Final Action*'s attempt to limit the claim language to being external from a designated internal system or providing to a third party is wrong and improper as such a limitation is simply not within the claim. Therefore,

because *Graham* fails to teach or suggest each and every feature of Appellants' claim 1, withdrawal of the present rejection is respectfully requested.

Appellants' claims 21, 30, and 37 include similar language as recited above with respect to Appellants' claim 1. For at least similar reasons as recited above with respect to Appellants' claim 1, *Graham* fails to teach or suggest every feature of Appellants' claims 21, 30, and 37. As such, Appellants' claims 21, 30, and 37 are allowable over the art of record.

Claims 2-6, 8-9, 11-20, and 31-34, which depend from claim 1, are allowable over the art of record for all the reasons given above concerning their respective base claim, and further in view of the novel features recited therein. Appellants' claims 22-29 and 35, 36, and 38-40, which depend from claims 21, 30, and 37, are allowable over the art of record for at least the same reasons as their ultimate base claim.

Appellants' dependent claims 5 and 6:

Appellants' claim 5 recites, "said web browser is a Java™ enabled web browser" and claim 6 recites, "said at least one applet is a Java™ applet." No portion of *Graham* teaches or suggests at least these features of Appellants' claims 5-6 or anything with respect to Java™.

Appellants' dependent claim 23:

Appellants' claim 23 recites, among other features, "displaying no ad when said textual content does not match said keyword data." The *Final Action* fails to recite a specific portion of *Graham* as teaching or suggesting at least this feature of dependent claim 23. Under the *Graham* Advertisement content recognizer 104 produces an output 22 comprising one or more advertising concepts from database 18 that are relevant to the contents of document 100. (Col. 5, ll. 55-58). *Graham* fails to teach or suggest that advertisements are not displayed when there is no textual match to keyword data.

Appellants' dependent claims 34, 35, and 36:

Still further, Appellants' dependent claim 34 recites, among other features, "wherein no data is collected to profile a user of the web browser." Under *Graham*, advertisements are then displayed to users based on user's concepts of interest. (Col. 6, l. 17). By the very operation of

Graham, user data ***must be collected*** and used for the user's concepts of interest. Therefore, *Graham*, by its very operation, cannot perform the features of Appellants' claim 34. As such, for at least this additional reason, *Graham* fails to teach or suggest the features of Appellants' claim 34.

Appellants' dependent claims 35 and 36 include similar features as recited above with respect to Appellants' claim 34. As described above with respect to Appellants' claim 34, *Graham*, by its very operation, cannot perform the features of Appellants' claims 35 and 36. As such, for at least this additional reason, *Graham* fails to teach or suggest the features of Appellants' claims 35 and 36.

Appellants' dependent claim 38:

Appellants' dependent claim 38 recites, among other features, "wherein no user profiling data is forwarded from the computer to the advertising server." No data is forwarded to the advertising server. The *Graham* system requires generation of a user profile file in order to generate an advertisement for a user. Under the *Graham* system, advertisements are only displayed based upon the generated user profile file.

Appellants' claim 38 is not anticipated by *Graham* for at least the reason that *Graham* displays ads based upon a user profile file forwarded to an ads database. Appellants disagree with the limitations that the *Final Action* places on the claim language. At page 9, the *Final Action* states, "[h]ere, the advertising server is part of the internal system and hence, the user's profile data are not collected and provided to any third party or external advertising server, rather are collected and used internally for targeting the users." Specifically, Appellants' claim 38 feature, "wherein no user profiling data is forwarded from the computer to the advertising server," recites absolutely ***nothing*** as to the advertising server being of a third party or external. The *Final Action*'s attempt to limit the claim language to being external from a designated internal system or providing to a third party is wrong and improper as such a limitation is simply not within the claim. Therefore, because *Graham* fails to teach or suggest each and every feature of Appellants' claim 38, withdrawal of the present rejection is respectfully requested.

<u>CONCLUSION</u>

For all of the foregoing reasons, Appellants respectfully submits that the final rejection of claims 1-6, 8-9, and 11-40 is improper and should be reversed.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Dated: December 20, 2007   By: /John M. Fleming/
                                                  John M. Fleming
                                                  Registration No. 56,536

1100 13th Street, N.W.
Suite 1200
Washington, D.C. 20005
Tel: (202) 824-3000
Fax: (202) 824-3001

CLAIMS APPENDIX
37 C.F.R. § 41.37(c)(1)(viii)

Claim 1: A system for providing Internet advertising, comprising:

an advertising server comprising a web server having at least one applet, said advertising server further comprising a database and a servlet for sending said at least one applet to a web browser on another computer and receiving textual content read from said web browser by said at least one applet, said advertising server comparing said textual content to keyword data stored in said database to determine whether to display an ad on said web browser,

wherein no user profiling data is forwarded to the advertising server.

Claim 2: The system for providing Internet advertising, as recited in claim 1, wherein said database comprises promotional heuristics.

Claim 3: The system for providing Internet advertising, as recited in claim 1, wherein said keyword data is provided for a plurality of subscriber advertisers, said keyword data corresponding to multiple ads.

Claim 4: The system for providing Internet advertising, as recited in claim 1, wherein said advertising server compares said textual content to said keyword data in real-time.

Claim 5: The system for providing Internet advertising, as recited in claim 1, wherein said web browser is a Java™ enabled web browser.

Claim 6: The system for providing Internet advertising, as recited in claim 5, wherein said at least one applet is a Java™ applet.

Claim 8: The system for providing Internet advertising, as recited in claim 1, wherein said ad is a banner ad.

Claim 9: The system for providing Internet advertising, as recited in claim 1, wherein said advertising server causes an ad specifying said keyword data to be displayed in said web browser when said keyword data matches words in said textual content displayed in said web browser.

Claim 11: The system for providing Internet advertising, as recited in claim 9, wherein said servlet receives data from said at least one applet, after being sent to the web browser, and said advertising server causes said web browser to display said ad specifying said keyword data.

Claim 12: The system for providing Internet advertising, as recited in claim 11, wherein said web browser displays a web site designated by said ad when said ad is selected.

Claim 13: The system for providing Internet advertising, as recited in claim 2, wherein said promotional heuristics determine which ad should be displayed.

Claim 14: The system for providing Internet advertising, as recited in claim 13, wherein said promotional heuristics are self-educating, so that when a user selects said displayed ad, said database is updated to indicate that said selected ad was a good match for said keyword data and said textual content.

Claim 15: The system for providing Internet advertising, as recited in claim 31, wherein said behavior graphics in said database contain information relating to the likelihood that a person interested in one topic will be interested in a second topic or will respond to an advertisement pertaining to said second topic.

Claim 16: The system for providing Internet advertising, as recited in claim 32, wherein said sponsorship authentication data in said database comprises information indicating sponsors who are subscribers to the system.

Claim 17: The system for providing Internet advertising, as recited in claim 1, wherein said database tracks a success rate of said displayed ad.

Claim 18: The system for providing Internet advertising, as recited in claim 33, wherein said usage records comprise data relating to how often each ad is accessed by users.

Claim 19: The system for providing Internet advertising, as recited in claim 18, wherein said keyword data for a corresponding ad is changed in response to said usage data.

Claim 20: The system for providing Internet advertising, as recited in claim 1, wherein said web browser is an HTML web browser.

Claim 21: A method of providing Internet advertising, comprising the steps of:

uploading ads to an advertising server;

selecting keyword data for each ad;

sending at least one applet to a web browser on a user's computer;

receiving from said at least one applet textual content displayed on said web browser;

comparing said textual content read by said at least one applet with said keyword data; and

displaying an ad having keyword data matching said textual content when said comparing step produces a match,

wherein no user profiling data is forwarded from the user's computer to the advertising server.

Claim 22: The method of providing Internet advertising, as recited in claim 21, wherein said steps of comparing and displaying said ad are executed in real-time.

Claim 23: The method of providing Internet advertising, as recited in claim 21, comprising the further step of displaying no ad when said textual content does not match said keyword data.

Claim 24: The method of providing Internet advertising, as recited in claim 23, comprising the further step of updating said keyword data when said textual content does not match said keyword data.

Claim 25: The method of providing Internet advertising, as recited in claim 21, comprising the further step of determining whether the user selects said ad in response to said displaying step.

Claim 26: The method of providing Internet advertising, as recited in claim 25, comprising the further step of displaying on the user's web browser a web site linked to said ad.

Claim 27: The method of providing Internet advertising, as recited in claim 26, comprising the further step of updating a database in said advertising server to note that said keyword data produced a successful target by bringing the user to said web site.

Claim 28: The method of providing Internet advertising, as recited in claim 25, comprising the further step of updating a database on said advertising server when the user does not click on said ad.

Claim 29: The method of providing Internet advertising, as recited in claim 21, wherein said ads are banner ads.

Claim 30: A method of providing real-time advertising over the Internet, comprising the steps of:

    maintaining a database of a plurality of ads;

    maintaining keyword data for each of said ads;

    sending an applet to a browser on a user's computer;

    reading textual content displayed on said browser using said applet;

    comparing said textual content read by said applet with said keyword data for each of said ads; and

    displaying an ad having keyword data matching said textual content when said comparing step produces a match,

wherein no user profiling data is forwarded from the user's computer to an advertising server.

Claim 31: The system for providing Internet advertising, as recited in claim 1, wherein said database comprises behavior graphics.

Claim 32: The system for providing Internet advertising, as recited in claim 1, wherein said database comprises sponsorship authentication data.

Claim 33: The system for providing Internet advertising, as recited in claim 1, wherein said database comprises usage records.

Claim 34: The system for providing Internet advertising, as recited in claim 1, wherein no data is collected to profile a user of the web browser.

Claim 35: The method of providing Internet advertising, as recited in claim 21, wherein no data is collected to profile the user of the web browser.

Claim 36: The method of providing real-time advertising over the internet, as recited in claim 30, wherein no data is collected to profile the user of the browser.

Claim 37: A system for providing Internet advertising, comprising a computer including a web browser and a display unit, the web browser receiving at least one applet from an advertising server,

      wherein the at least one applet reads textual content displayed on said web browser,

      wherein the web browser displays an ad specifying keyword data when words in the textual content match the keyword data,

      wherein the ad is received from the advertising server,

      wherein no data is collected to profile a user of the computer.

Claim 38: The system of claim 37, wherein no user profiling data is forwarded from the computer to the advertising server.

Claim 39: The system of claim 37, wherein the keyword data is based upon promotional heuristics.

Claim 40: The system of claim 39, wherein said promotional heuristics are self-educating, so that when the user selects said displayed ad, a database at the advertising server is updated to indicate that said selected ad was a good match for said keyword data and said textual content.

EVIDENCE APPENDIX

37 C.F.R. § 41.37(c)(1)(ix)

None.

RELATED PROCEEDINGS APPENDIX
37 C.F.R. § 41.37(c)(1)(x)

None.